

REMARKS

Claims 1-52, 57-68, and 73-82 are pending in this application. Applicant has amended claims 1-52, 57-68, and 73-76 to more particularly point out and distinctly claim applicant's invention. Applicant has deleted claims 53-56 and 69-72 and has added new claims 77-82. No new matter has been added by way of these amendments.

Objection to Specification

The Examiner has objected to the placement of the title of the application. Although the title is the first line in the application, it may appear to the Examiner that the Express Mail information, which was part of the page header, is incorrectly placed. Thus, by amendment above, applicant has removed the Express Mail number (and its box), and the title of the application, "Multi-Vendor Transactions Based on Near-Immediate Rebate Detection" is now apparent as the first line at the top of the specification on the first page; thus, rendering the objection moot. Applicant respectfully requests withdrawal of the objection to the specification.

Objection to the Claims

The Examiner has objected to the claims commenting that "it appears that the Applicant in many instances, within the claimed invention, uses the terms **vendor** and **retailer** interchangeably. It is important that the definition of terms remain consistent ..." [Office Action, dated 2/27/03, page 2 (hereinafter "Office Action")]. The Examiner further comments that he considers a "**vendor to be a coupon issuer 14 or distributor 16 and a retailer to be the owner of a retail store where coupons can be redeemed.**" [Office Action, page 2.]

Applicant respectfully disagrees and submits that the applicant has not used the terms inconsistently in the claims or in the specification of this application. Rather, according to applicant's specification and claims, a vendor can be a retailer, amongst other entities. A retailer can also be the owner of a retail store where coupons or in-store discounts may be redeemed. Specifically, according to applicant's specification, a retailer "generally refers to a retail outlet such as a supermarket or grocery store which typically retails manufacturers' or wholesaler's goods, *although retailers can also sell their own goods* (e.g., 'store brands')." [Specification, page 13, lines 24-28 (emphasis added).] Vendors are "purveyors of goods and/or services" and

examples of them *include* terms such as “manufacturers,” “*retailers*,” “wholesalers,” etc. [See Specification, page 13, lines 15-20, 24-28 (retailers that sell their own goods are purveyors of goods, hence vendors); page 14, lines 4-7; and page 16, lines 24-25.] A vendor can provide rebate vehicles in many different forms, including “coupons” and “in-store specials.” [Specification, page 2, lines 15-29.] Retailer stores can provide “in-store” rebate vehicles and coupons relating to their own brands. [See, *e.g.*, Specification, Figure 3.]

It appears that the Examiner takes his definition of vendor and retailer from a reference (Barnett) used to reject the claims. This is not the definition that applicant’s specification explicitly uses to define the term “vendor.” It is inappropriate for the Examiner to impose another definition, as an applicant is permitted to be his or her own lexicographer. Accordingly, applicant respectfully requests withdrawal of this objection to the claims.

35 U.S.C. § 101 Rejection

The Examiner has rejected under 35 U.S.C. § 101 claims 1-22 and 45-60 as directed to non-statutory subject matter in that they pertain to a manual process. Applicant has amended independent claims 1 and 45 to recite the language “A method in a computer system ... comprising:” to make clear that the acts of the methods of claims 1-22 and 46-60 are performed by a computer implementation of the processes described. As described in the specification in Figure 1 and elsewhere, the methods recited in claims 1-22, 45-60, and in new claims 77-82 are performed by one or more computer systems that comprise a network of computer systems. Applicant thus respectfully requests the Examiner to withdraw this rejection.

35 U.S.C. § 112 Rejection

The Examiner has rejected claim 46 under 35 U.S.C. § 112 because the term “the vendor-identifier list” lacks proper antecedent basis. Applicant has amended claim 46 and has deleted the language “the vendor-identifier list,” thus rendering the rejection moot. Applicant thus respectfully requests the Examiner to withdraw this rejection.

35 U.S.C. § 102 Rejection

The Examiner has rejected claims 1-76 under 35 U.S.C § 102(e) as being anticipated by Barnett et al. ("Barnett"), U.S. Patent No. 6,321,208, issued November 20, 2001, and with a filing date of April 19, 1995. Applicant respectfully traverses this rejection for the reasons discussed in detail below with respect to both the original and amended claims (assuming that the §112 corrections are applied to the original claims to make clear that the acts of the methods are being performed by a computer system).

In summary, Barnett is directed to a different aspect of electronic coupon distribution – that of targeting coupon packages for specific types of coupon users based upon consumer research data. In contrast, applicant's claims are directed generally to computer systems and computer-implemented methods for managing multiple vendor transactions that occur with respect to a multi-vendor rebate list that provides rebate information and near-immediate redemption processing/accounting for a multitude of vendors. The systems/methods track rebates as they are redeemed (in near-immediate time) and manage the redemption process electronically on behalf of vendors. Barnett is not at all directed to, nor does Barnett describe, *any mechanism for a vendor to electronically obtain information*, let alone rebate information stored in a multi-vendor rebate list or information respecting what monies are owed to a specified retailer.

Applicant provides the following descriptions of applicant's techniques and the Barnett reference for the Examiner's convenience, followed by a discussion of the reasons applicant's claims before and after amendment are allowable over Barnett.

Applicant's Techniques

The following overview of applicant's techniques recites passages from the specification for convenience of the Examiner and is not intended to interpret or to limit the claims in any manner.

Applicant's techniques provide a network-based, centralized system for the near real-time management of the storage, distribution, tracking, and redemption of rebates for a multiplicity of vendors. Applicant's techniques and described systems provide ways to organize and manage rebate vehicles of all different types in a central computer system (which can be one

or more physical computer systems) to streamline electronic distribution to potential consumers and to automatically handle the redemption process *in near real-time* on behalf of vendors and retail outlets. [See Specification, Figure 1; Figures 8-10 with corresponding text on page 30, line 15–page 33, line 17.]

In summary, a rebate vehicle typically is redeemed by presenting the rebate vehicle to a retail facility along with the item being purchased to which the discount applies. A bar code on the rebate vehicle is (typically) scanned in by a computer system located within the retailer's facilities (*e.g.*, a checkout stand). [Specification, page 26, lines 3-13.] According to applicant's techniques, the redeemed coupon is then tracked in near-immediate time, by a retailer's computer system communicating with a computer system that maintains a multi-vendor rebate list 204 (in one embodiment a central computer system 150) to update the rebate list 204 to indicate that a coupon was redeemed and to record a corresponding rebate redemption transaction. [See, *e.g.*, Specification, Figures 6-8 and associated text.] The rebate value is then applied by the retail facility to the item being purchased.

More specifically,

“coupon reimbursement application program 606 ... via messaging 601, informs Web server software 202 that a bar code for one of the ... manufacturer's ... coupons has been scanned.... In response to messaging 610, Web server software 202 causes the volume-of usage counter for the ... manufacturer's ... coupon to be incremented.”

[Specification, page 26, lines 20-27.] The Web server software 202 then sends a response message to indicate that a corresponding volume-of-usage counter has been incremented. [Specification, page 26, lines 28-32.] A redemption log that is associated with the retail facility that redeemed the rebate vehicle and the source vendor of the rebate vehicle is then updated with a record of the redemption transaction. [Specification, page 28, lines 23-33.] For example, in response to a message (from the retail facility) indicating a rebate vehicle has been redeemed, when the redemption value is determined in near real-time (as opposed to scanned from the bar code of the rebate vehicle),

“Web server software 202 ... [determines] the value of [the] ... manufacturer's ... coupon; (b) logs the type of coupon, time, and date of redemption..., and value of the coupon ... at the time and date of redemption; and (c) ... informs coupon reimbursement application program 606 of the value of the ... coupon at the time and date of redemption and that the redemption transaction has been logged.”

[Specification, page 28, lines 23-33.] At that point, the computer system of the retail facility “applies the coupon against the [item] purchased by a user in a fashion well-known to those having ordinary skill in the art. [Specification, page 29, lines 2-5.]

According to applicant’s techniques, vendors and retail facilities where rebate vehicles are redeemed can query the computer system that maintains the multi-vendor rebate list (e.g., central computer system 150) at any time to assess rebate information respecting rebates that are associated with the requesting vendor. For example, a vendor (e.g., a manufacturer) can use applicant’s systems and methods to obtain “substantially real-time accounting of monies owed by various parties... to various other parties during various periods of time.” [Specification, page 30, lines 10-13; Figures 8-9 and associated text.] In addition, the owner/operator of the computer system that maintains the multi-vendor rebate list (e.g., central computer system 150) can “disburs[e] money owed by the specified manufacturer to the specified retailer ... and [bill] the specified manufacturer for disbursement to the specified retailer on the basis of the value of coupon transactions per the specified time period... the number of coupon transactions per the specified time period..., [or] a fee for answering the inquiry as to monies owed.” [Specification, page 32, lines 20-page 33, line 16.] Thus, the near real-time redemption process of applicant’s techniques obviates the need for the physical redemption centers of the prior art and for the process of counting individual coupons, a process which is duplicated by each redemption center and by each vendor for each redemption location. [See Specification, Figure 1; Figures 8-10 with corresponding text on page 30, line 13 – page 33, line 23; and description of traditional redemption center processing on page 4, line 2 – page 5, line 2.]

The Barnett Reference

Barnett is directed to targeting coupon packages for specific types of coupon users based upon consumer research data processing known in the art and to providing coupons electronically to consumers. As described in Barnett, a coupon distributor 16 stores information in a database 11 and uses “a marketing and targeting analysis means 17 [to carry] out the function of analyzing the aforementioned information in a manner known in the art to arrive at different coupon packages.” [Barnett, 12:26-33, 37-41.] Examples of the data stored in database

11 used to arrive at coupon packages include, "coupon data selected by the user, coupon data printed by the user, and the requested demographic information...[and] information from the coupon redemption center 13 regarding the coupons actually redeemed by the user." [Barnett, 12:29-33.] "The analysis means generates a number of differing coupon data packages for transmittal to the online service provider ... [and] provides specific mapping information which will instruct the online service provider as to which user should be provided with which package(s)." [Barnett, 12:51-56.] Once coupon packages are determined, they are transmitted with the mapping information to the online service provider. [Barnett, Figure 1 and Figure 10 and associated text.]

The online service provider 2 stores the transmitted coupon packages in coupon packages file 40 as packages of coupons along with advertising packages and the mapping information. [Barnett, Figure 10; 8:14-16.] When a consumer joins the coupon service described by Barnett, the online service provider downloads coupon packages and "an offline coupon management program" to a consumer's personal computer. The consumer is then able to view additional coupon packages, download them, organize coupons, and print coupons (each once) for use.

Barnett refers to the use of standard prior art coupon redemption centers that use traditional means for redemption processing. As stated,

"printed coupons 18 are used in the normal fashion by a consumer when shopping at a desired retail store 10. ... The redeemed coupons 18 are transmitted to a coupon redemption center 13 where they are electronically read, and user-specific data is stored in a coupon redemption database 12.... The coupon redemption center 13 receives from a number of stores 10 the coupons redeemed, verifies the value of the redeemed coupons, determines the identification of users who redeemed the coupons, and distributes the information read from the coupons 18 to the individual coupon issuer 14 and to the coupon distributor 16. In particular, information regarding the redemption amount and the redeeming store 10 is forwarded to the particular coupon issuer 14 named on the coupon 18, which then credits the redeeming store 10 with the total amount of discounts given."

[Barnett, 7:12-20, 36-45.] No further description for how retail stores are reimbursed is provided.

Barnett also mentions in passing that a "coupon may be redeemed electronically by sending the coupon data in the output buffer ... to the online service provider ... [for use] in

the ‘electronic shopping mall’ environment... it could also be routed ... [to] a retail store where the user will be shopping ... [and] held... pending purchase by the user of the matching product.” [Barnett, 11:33-43.] No description of this process is provided by Barnett.

Remarks Regarding 35 U.S.C. § 102 Rejection

As mentioned, the Examiner has rejected claims 1-76 under 35 U.S.C § 102(e) as anticipated by Barnett. The essence of the Examiner’s rejection appears to be that Barnett describes a system for distributing electronic coupons over the Internet that includes applicant’s “multi-vendor rebate list” and allows vendors to obtain rebate list related information “from the system” upon request. Specifically, the Examiner equates the database 40 of the online service provider 2, which stores coupon packages (see Barnett, Figure 10), to applicant’s multi-vendor rebate list (see, *e.g.*, specification, Figure 3) and states that,

“[i]t is to be further understood that ... vendors or manufacturers or coupon issuer 14 and distributor 16 *should be able to receive*, from the system... information related, for example, to the number of downloaded coupons, ..., subsequent to transmitting a request (inquiry) requesting such information from [online service] provider 2...”

[Office Action, page 5 (emphasis added).] The Examiner thus appears to reason that applicant’s claims 1-76 (prior to amendment), which are directed generally to providing information from the multi-vendor rebate list upon request by a vendor, are somehow taught or suggested by Barnett.

Applicant respectfully disagrees for several reasons. First, the Examiner appears to be overstating what Barnett describes and to be engaging in impermissible hindsight reconstruction using applicant’s claims templates to attribute capabilities and features to Barnett other than what are explicit or even implicit in the reference. Second, even assuming that the database 40 of the online service provider 2 is somehow related to applicant’s recited “multi-vendor rebate list,” which it is not, Barnett *nowhere describes, mentions, or even suggests that a vendor* (*e.g.*, an issuer of a coupon or rebate vehicle) *can make electronic requests to obtain rebate information from the database 40 of the online service provider 2* as implied by the Examiner. Third, the redemption processing passages of Barnett are specifically directed to prior art (manual) redemption processing, which has nothing to do with applicant’s claims, before or

after amendment. Thus, for these reasons and others, Barnett does not teach, suggest, or motivate any of applicant's claims 1-76 (before or after amendment) or new claims 77-82.

More specifically, each of applicant's independent claims, both prior to and after amendment, recite language that is directed to receiving a message from a vendor to obtain information that is associated with the vendor from the multi-vendor rebate list. This information can be used to record rebate vehicle redemption events, query as to monies owed, or reimburse retailers by distributing funds according to recorded redemption transactions. Specifically, claim 1 as amended (hence dependent claims 2-22) recites,

1. A method in a computer system ... the computer system maintaining a multi-vendor rebate list with rebate data ... associated with each of the vendors, comprising:
receiving a *multi-vendor rebate list related message from a vendor*; and
in response to the received message, *dispensing information related to a portion of the multi-vendor rebate list* relating to the vendor.

(The amended claim language is recited throughout this response for clarity; although applicant maintains that similar language supporting theses same arguments was present in the claims that were before the Examiner.)

Similarly, claim 45 (hence dependent claims 30-42) recites,

45. A method in a computer system ..., comprising:
displaying information in response to receiving a *multi-vendor rebate list vendor identifier*.

Apparatus claims 23 and 61 (hence dependent claims 24-44 and 46-76) recite similar language to claims 1 and 45, respectively.

Nowhere in Barnett is anything described that resembles a "multi-vendor rebate list related message from a vendor" or a "multi-vendor rebate list vendor identifier." Nothing in Barnett is addressed to such aspects of a system. Barnett doesn't even acknowledge a need for such a capability – it is directed to different phases in the coupon distribution process – targeting coupon packages and obtaining market research types of information from users of coupons. Further, there is no mention of "vendors" *per se*. Even if coupon issuers and distributors are presumed to play such a role in the Barnett system, there is absolutely no mention in Barnett of electronic interaction by them with the database 40 of the online service provider 2. Barnett is not at all directed to, nor does Barnett describe, *any mechanism for a vendor to electronically*

obtain any information, let alone rebate information stored in a multi-vendor rebate list or information respecting what monies are owed to a specified retailer (as recited in several dependent claims).

The Examiner presumes, without more, that the vendors can request such information *from the online service provider* (and thus access the database which the Examiner incorrectly compares to the multi-vendor rebate list). Applicant's representative has performed a thorough reading of Barnett and cannot find support for this assertion anywhere. In fact, such a reading of Barnett is nonsensical because Barnett is directed to a different problem, and Barnett refers to the use of standard prior art coupon redemption centers that use traditional means for redemption processing and for getting user-specific information for marketing analysis to the coupon distributors. (See description of Barnett reference above.). Applicant respectfully requests the Examiner to specifically point out where in the Barnett reference this assertion is supported.

Therefore, because one or more aspects (acts or elements) of applicant's claims 1-76 are not taught, suggested, or motivated by Barnett, Barnett cannot possibly anticipate applicant's claims.

Further, contrary to an apparent suggestion by the Examiner, there is no teaching, suggestion, or motivation in Barnett to use "multi-vendor rebate list vendor identifiers" for displaying information as recited in claims 45-76. Specifically, on page 11 of the Office Action, the Examiner states that

"it is inherent in the prior art (current reference) that each coupon issuer 14 and distributor 15 (vendor or manufacturer) is assigned an ID, account number or identifier or code used to identify the coupon issuer 14 or distributor 15, who provides the coupons. The coupon issuer 14 or distributor 16 can also use the identifier ... to access the ...[online service] provider 2 (as discussed above)..."

It appears to applicant's representative that the phrase "as discussed above" refers to Examiner's early assertion that a vendor "should be able to receive, from the system... information ... subsequent to transmitting ... a request [to]... provider 2." As mentioned above, applicant's representative has performed a thorough reading of Barnett and cannot find support for this assertion anywhere. It is impermissible hindsight reconstruction to add capabilities to a reference in a manner taught by applicant's claims. Applicant respectfully requests the Examiner

to point out where in the reference it is inherent to have such a vendor identifier as recited by applicant's claims *that is associated with a multi-vendor rebate list*. The problem addressed by Barnett doesn't necessitate having a vendor identifier as recited in applicant's claims. Even if a coupon issuer or distributor has an identifier for identification purposes, a vendor identifier used for one purpose is not a teaching or suggestion to use it for another. Thus, one or more additional aspects of claims 45-76 are not taught, suggested, or motivated by Barnett.

The dependent claims further recite that the dispensed [or displayed] information can be used to perform transactions relating to tracking and recording redeemed coupons, querying regarding monies owed, or for billing vendors. For example, dependent claim 3 recites that the dispensed information can be used to

“inform a manufacturer of a payment owed to at least one retailer, the payment based, at least in part, on at least one recorded rebate transaction.”

As another example, dependent claim 21 recites,

“transmitting billing data to the vendor for the dispensing information related to the multi-vendor rebate list.”

The remaining dependent claims recite similar aspects of tracking and recording redeemed coupons, querying regarding monies owed, or for billing vendors and similar functionality. For the sake of brevity and advancing prosecution, applicant is not reviewing each of these claims in detail.

There is absolutely nothing in Barnett that addresses these aspects of applicant's dependent claims. Barnett instead refers to the use of standard prior art coupon redemption centers that use traditional means for redemption processing and for getting to the coupon distributors user-specific information for marketing analysis. (See description of Barnett reference above.) In addition, there is absolutely no mention in Barnett of how any entity is billed, let alone a vendor. Further, according to applicant's specification, this traditional process can take several weeks or months. [Specification, page 4, lines 21-25.] Thus, one or more aspects of applicant's dependent claims 2-22, 24-44, 30-42, and 46-76 are also not taught, suggested, or motivated by Barnett.

In addition, when rejecting several claims, the Examiner attributes other capabilities to Barnett that, to the best of applicant's representative's knowledge, are nowhere

described or implied by the reference. Applicant's representative has thoroughly searched the Barnett reference and is unable to locate these capabilities. For the purpose of expediting prosecution, applicant is pointing out a few of these for reference, and reserves the right to traverse them all in the future if necessary. Applicant respectfully requests that the Examiner point out where in the Barnett reference, such capabilities are found.

For example, on page 5, the Examiner states,

"In a further embodiment, the user is conducting a business transaction with an online shopping mall.... So as to detect (search) in the customer's order any matching UPC code associate with a discount coupon, stored in database 40 on online service provide 2, and if a matching UPC code is found, the value of the coupon is determined or generated in real-time (generating a coupon) and a price reduction is automatically applied to the customer's order."

The Examiner describes, in detail, a process for using coupons for on-line redemption that is nowhere found in Barnett or in any other reference cited by the Examiner. No such capability is described by Barnett. Applicant respectfully requests the Examiner to explicitly point out where in Barnett this process is described.

New Claims

New claims 77-82 have been added; however, no new matter has been added.

Specifically, new claim 77 is dependent from claim 1 and directed to dispensing information in near real-time. New claims 78-79 are dependent from claim 1 and are directed to messages of redemption by scanning. Claims 77-79 thus are not taught, suggested or motivated by Barnett for the same reasons discussed with reference to claim 1.

New claims 80-82 are dependent from claim 23 and are directed to similar subject matter as claims 77-79. Thus, claims 80-82 are not taught, suggested or motivated by Barnett for the same reasons discussed with reference to claims 1 and 23.

Conclusion

For the reasons discussed above, and others, claims 1-82 are distinguishable from Barnett and are thus allowable. The Barnett reference does not teach, suggest, or motivate several of the acts and elements recited in independent claims 1, 23, 45, and 61. Similarly, because the remaining dependent claims depend from at least one independent claim, dependent

claims 2-22, 24-44, 46-60, and 62-82 also incorporate features that are not taught, suggested, or motivated by either reference. Therefore, applicant respectfully submits that claims 1-82 are allowable.

In closing, applicant respectfully requests the Examiner to reconsider this application and its early allowance. The Commissioner is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090. The Examiner is invited to contact applicant's representative at (206) 622-4900 should the Examiner have any further questions.

Respectfully submitted,

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